Supreme Court of the United States.

OCTOBER TERM, 1898.

No. 253.

OFFICE SPECIALTY MANUFACTURING COMPANY,
Appellant,

vs.

FENTON METALLIC MANUFACTURING COMPANY,
Appellee.

Appeal from the Court of Appeals of the District of Columbia.

This is a suit in equity brought by the Fenton Metallic Manufacturing Company, against the Office Specialty Manufacturing Company, for infringement of letters patent No. 450,124, granted April 7, 1891, to the plaintiff, as the assignee of the inventor, H. J. Hoffman, for Improvements in Storage Cases for Books, etc.

An interlocutory decree was passed by the Supreme Court of the District of Columbia on the 3rd day of June, 1893, holding the Hoffman patent to be valid as to its first and second claims, and holding, further, that the defendant by the manufacture and sale of roller shelves like the shelf illustrated in "Exhibit Office Specialty Mfg. Co.'s Catalogue, Fig. 17,"

and like the shelf shown in "Exhibit Hansmann's Sketch," infringed said first and second claims, and the cause was referred to the Auditor to take and state an account of the profits and damages growing out of the said infringements.

Proceedings were in due course commenced before the Auditor, but the plaintiff, not satisfied with adducing proof as to the profits and damages growing out of the manufacture and sale of shelves by the defendant like those specifically passed upon by the court and mentioned in the interlocutory decree, endeavored to show that a shelf made by defendant subsequent to the interlocutory decree and known in the cause as "Defendant's New No. 4 Shelf" was also an infringement of the patent in suit and, against defendant's objection, requested the Auditor to take an account respecting said new shelf.

On the question of the alleged new infringement, the Auditor was somewhat embarrassed by the fact that his Honor, Judge Bingham, who had passed the interlocutory decree of June 3, 1893, had filed no opinion indicating what was, in his judgment, the true construction to be given to the patent in suit. Nevertheless, the Auditor proceeded to determine the issue as best he could. He found that the defendant's New No. 4 Shelf was an infringement of claims 1 and 2 of the plaintiff's patent; he found that the plaintiff was entitled to no damages whatever growing out of the manufacture and sale by the defendant of either of the forms of shelves complained of; and he further found that defendant had made a profit from the manufacture and sale of each kind of shelf complained of. He embodied his findings in a report found in the record (p. 283).

To this report defendant filed twelve exceptions (p. 296).

After a hearing upon defendant's exceptions, His Honor, Judge Cox, in an interlocutory decree dated April 5, 1897, allowed the 4th and 9th Exceptions, relating to the alleged new infringement, which he held the Auditor had no authority

to inquire into, and overruled the 1st, 2nd, 3rd, 5th, 6th, 7th, 8th and 12th Exceptions, affirming the report excepting as to the matters set forth in the said 4th and 9th Exceptions (p. 298). Subsequently a final decree was entered confirming the interlocutory decrees of June 3, 1893, and April 5, 1897, and requiring that the defendant pay to the plaintiff the sum of $5.780.17, with interest from the 15th day of January, 1897, the date when the report of the Auditor was submitted to the court, and also the costs of the suit. From all of this final decree, excepting the portion thereof sustaining defendant's Exceptions Nos. 4 and 9, the defendant appealed to the Court of Appeals of the District of Columbia, and the plaintiff, by cross appeal, appealed from so much of said final decree as sustained said Exceptions 4 and 9.

The Court of Appeals in determining the appeal and cross appeal affirmed so much of the decree of the Supreme Court of the District of Columbia as was appealed from by the defendant, and reversed so much of said decree as was appealed from by the plaintiff, and remanded the cause to the court below with directions to reform the decree below by vacating so much thereof as sustained the defendant's exceptions to the Auditor's report and by decreeing recovery by the complainant of the amount reported by the Auditor as owing on account of the infringement of its patent by the defendant's "New No. 4 Shelf." The effect of this decree of the appellate court was to add to the amount awarded by the court below, i. e. $5,780.17, with interest from January 15th, 1897, the amount found due by the Auditor, growing out of the manufacture and sale by defendant of the "New No. 4 Shelf," i. e. $4,777.53, making the total award $10,557.70, with interest. From the decree of said Court of Appeals this appeal is taken under Section 8, of the Act of February 9, 1893, establishing said Court of Appeals (27 Stat. p. 434) which provides:

> "Sec. 8. That any final judgment or decree of the said Court of Appeals may be re-examined and

> affirmed, revised, or modified by the Supreme Court of the United States, upon writ of error or appeal, * * * in cases, without regard to the sum or value of the matter in dispute, wherein is involved the validity of any patent or copyright * * *."

The appellant relies upon the following assignments of error, viz:

I. That the Court of Appeals of the District of Columbia erred in holding letters patent No. 450,124, to be good and valid in law.

II. That said court erred in holding that Horace J. Hoffmann was the original and first inventor of the invention described and claimed in said letters patent No. 450,124.

III. That said court erred in holding that defendant had infringed claims 1 and 2 of said letters patent No. 450,124, by using and vending roller shelves such as illustrated in "Figure 17 of Complainants Exhibit Office Specialty Manufacturing Company's Catalogue."

IV. That said court erred in holding that defendant had infringed claims 1 and 2 of said letters patent No. 450,124, by using and vending roller shelves such as illustrated in "Complainant's Exhibit Hansmann's Sketch."

V. That said court erred in holding that the defendant had infringed claims 1 and 2 of said letters patent No. 450,124, by using and vending roller shelves such as illustrated in "Exhibit New No. 4 Roller Shelf."

VI. That the said court erred in overruling defendant's first exception to the Auditor's Report, reading as follows:

> *First Exception.*—For that the said Auditor in his said report found that the shelves of the form and description illustrated in "Exhibit Office Specialty Mfg. Co.'s Catalogue, Fig. 17," and of the form and description illustrated in "Exhibit Hansmann Sketch" were sold by the defendant at an average price of $2.27 per shelf in combination with cases, whereas he should have found that he was unable to ascertain what was

the average selling price of said shelves in combination with cases, and that there was no competent evidence from which to determine such average selling price.

VII. That the said court erred in overruling defendant's second exception to the Auditor's Report, reading as follows:

Second Exception.—For that the said Auditor in his said report found that the average cost to the defendant of the manufacture of shelves of the form and description illustrated in "Exhibit Office Specialty Mfg. Co.'s Catalogue, No. 17," and of the form and description illustrated in "Exhibit Hannsman Sketch" in combination with cases was 99 cents per shelf, whereas he should have found that he was unable to find from the evidence what such cost of manufacture was.

VIII. That the said court erred in overruling defendant's third exception to the Auditor's Report, reading as follows:

Third Exception.—For that the said Auditor in his said report found that the estimated average cost price to defendant of the shelves alone was 49½ cents per shelf (the same being one-half of the estimated average cost of shelf and case together), whereas, in view of the certain and explicit evidence afforded by "Exhibit Shelves Without Cases," and defendant's statement of November 20, 1896, page 156, Auditor's Record, showing that the lowest actual cost price to the defendant of any shelf without a case was 70 cents per shelf and the average cost price of 2,206 shelves without cases was a fraction over 87 cents per shelf, he should have found that the average cost price to defendant of a shelf alone was not less than 87 cents and a fraction.

IX. That the said court erred in overruling defendant's fourth exception to the Auditor's Report, reading as follows:

Fourth Exception.—For that the said Auditor in his said report found that the new No. 4 roller shelf is substantially the same in form and description as the shelf illustrated in "Exhibit Office Specialty Mfg. Co.'s Catalogue, Fig. 17," and in "Exhibit Hansmann Sketch" and an infringement of claims 1 and 2 of the Hoffman patent in suit, whereas he should have found that said

new No. 4 roller shelf was substantially different from said above-mentioned exhibit shelves and not an infringement of said claims 1 and 2 of the Hoffman patent in suit.

X. That the said court erred in overruling defendant's fifth exception to the Auditor's Report, reading as follows:

> *Fifth Exception.*—For that the said Auditor in his said report found that the average gross proceeds of the sales attributable to the shelves separately from cases is $1.135 per shelf, whereas he should have found that he was unable to ascertain from the evidence the average gross proceeds

XI. That the said court erred in overruling defendant's sixth exception to the Auditor's Report, reading as follows:

> *Sixth Exception.*—For that the said Auditor in his said report found that the average cost of manufacture of said shelves separate from cases is .495 per shelf, whereas he should have found from the evidence afforded by "Exhibit Shelves Without Cases" and defendant's statement of November 20, 1896, page 156, Auditor's Record, that the average cost of manufacture of said shelves separate from cases was not less than 87 cents and a faction per shelf.

XII. That the said court erred in overruling defendant's seventh exception to the Auditor's Report, reading as follows:

> *Seventh Exception.*—For that the said Auditor in his said report found the net profits realized by the defendant from the sale of the 25 shelves like "Exhibit Office Specialty Mfg. Co.'s Catalogue, Fig. 17," to September 1, 1896, to be $5.125, as shown in Schedule B, whereas he should have found that defendant had realized no profits from the sale of said shelves."

XIII. That the said court erred in overruling defendant's eighth exception to the Auditor's Report, reading as follows:

> *Eighth Exception.*—For that the said Auditor in his said report found the net profits realized by the defendant from the sale of the shelves described in "Exhibit

Hannsman Sketch" to be $5,775.05, as shown in Schedule B, whereas he should have found that defendant had realized no profits from the sale of said shelves.

XIV. That the said court erred in overruling defendant's ninth exception to the Auditor's Report, reading as follows:

> *Ninth Exception.*--For that the said Auditor in his said report found the net profits realized by the defendant from the sale of the shelves designated as New No. 4 roller shelf to September 1, 1896, to be $4,777.53, as shown in Schedule D, whereas he should have found that defendant had realized no profits from the sale of said shelves.

XV. That the said court erred in overruling defendant's tenth exception to the Auditor's Report, reading as follows:

> *Tenth Exception.*—For that the said Auditor in his said report refused to consider the testimony of Alexander S. Steuart, an expert witness called by defendants, on the question of the infringement of the new No. 4 shelf, whereas he should have considered and given due weight to said testimony on said question.

XVI. That the said court erred in overruling defendant's eleventh exception to the Auditor's Report, reading as follows:

> *Eleventh Exception.*—"For that the said Auditor in his said report refused to consider the testimony of the said Alexander S. Steuart respecting the prior state of the art in relation to claims 1 and 2 of the Hoffman patent in suit and the bearing of said claims on the alleged infringing New No. 4 shelves, whereas said Auditor should have considered and duly weighed said testimony on said question.

XVII. That the said court erred in overruling defendant's twelfth exception to the Auditor's Report, reading as follows:

> *Twelfth Exception.*—For that the said Auditor in his said report has awarded plaintiff profits alleged to have been realized by the defendant, notwithstanding it appears from the bill of complaint and evidence offered by the plaintiff that the plaintiff manufactures under the

Hoffman patent in suit, and neither the bill nor the evidence discloses that the plaintiff has marked its article made under said patent with the word "patented," together with the day and year the patent was granted, nor that the defendant was duly notified of its infringement and continued after such notice to make, use, or vend the article so patented, whereas he should have refused to award any profits or damages because of the inhibition of Sec. 4900, Revised Statutes.

XVIII. That the said court erred in affirming so much of the decree of the Supreme Court of the District of Columbia as was appealed from by the defendant, Office Specialty Manufacturing Company, and in reversing so much of said decree as was appealed from by the complainant, Fenton Metallic Manufacturing Company; that it erred in decreeing the cost of both said appeals should be paid by said defendant and further erred in remanding said cause to the Supreme Court of the District of Columbia, with directions to reform the decree of that court by vacating so much thereof as sustains the exceptions to the Auditor's Report and by decreeing recovery by the complainant of the amount reported by the Auditor as damages on account of the infringement of its patent by defendant's "New No. 4 Shelf."

XIX. That the said court erred in awarding an injunction against said defendant.

XX. That the said court erred in not dismissing the plaintiff's bill of complaint for want of equity with costs to the defendant.

It is proper at this point to state that the Hoffman patent in suit has been also adjudicated in the United States Circuit for the Southern District of New York in Fenton Metallic Mfg. Co. *vs.* Chase, *et al.* On a motion to vacate a default order for a preliminary injunction in that cause, Judge Lacombe doubted the validity of the patent and vacated the injunction, (73 Fed. 831) and on final hearing upon full pleadings and proofs, Judge Wheeler held the patent invalid for want of

novelty in the invention and dismissed the bill. (84 Fed. 893.)

This case, therefore, in effect, calls for a review by this court of the conflicting opinions of the Court of Appeals of the District of Columbia and of the United States Circuit Court for the Southern District of New York.

THE HOFFMAN PATENT IN SUIT IS INVALID.

Appellant's first point is, that the patent in suit is invalid and void for lack of patentable invention in the subject-matter. This, if determined in its favor, is decisive of the whole case.

Although the title of the patent is "Improvements in Storage Cases for Books," the particular contrivance alleged to be protected by the claims, (1 and 2) put in issue is what is known as a roller shelf, which may be defined generally, as a shelf provided with rollers for facilitating the introduction and withdrawal of heavy books from a book case provided with such shelves and having a hand space or recess for enabling the back of the book to be readily grasped. At the date of Hoffman's application for patent—for that date in the absence of other proof must be taken to be the date of his alleged invention—roller shelves had already gone into extensive use and numerous patents had been granted for various improvements in them.

HARRIS PATENT OF 1870.

Patent to Harris, (p. 143–144), No. 107,042, of September 6, 1870, (now public property), shows a roller-shelf for record books consisting of a frame-work in which are mounted three parallel rollers that are adapted to support a book, the free rotation of the rollers serving to facilitate the introduction and removal of the books to and from the shelf.

BOONE PATENT OF 1876.

Patent to Boone, (p. 145), No. 182,157, dated September 12, 1876, (also public property), shows a book case having

at the front edge of each of its shelves a roller arranged so that when a book is withdrawn from or placed upon the shelf it will move over a roller instead of over the edge of the shelf.

The patentee says:

> The edges of book shelves are ordinarily made sharp, so that a book which is frequently taken down from and replaced upon the shelves, soon becomes worn out, its lower edges being destroyed by the sharp corners of the shelves on which it is dragged, especially if the shelf upon which it is kept is higher than the level of the person's head who handles it or if the books are very heavy, such as books of record and heavy account books.
>
> To obviate the difficulty, I insert a roller. C, just in front of the edge of each shelf, so that the lower edges of the book will rest upon and roll over the roller both when the books are being taken down from the shelf or placed upon it.

WOLFE PATENT OF 1879.

Patent to Wolfe (p. 147), No. 220,265, dated October 7, 1879 (also public property), shows a bookcase in which several series of rollers are employed to afford the support for a book placed upon the shelf, each series of rollers being supported on what the patentee terms a "box," so that the rollers may have free rotation, and also so that the hand of the operator may be introduced between the series of rollers in order to more readily grasp the back of the book, either in removing it or returning it to its place, without liability of the fingers being caught by any portion of the shelf.

The specification states (p. 148):

> The object of this invention is to provide means to hold heavy record books and other tomes, which will lessen the labor and impairing of the books while handling them, and admit of their removal and replacement, so as to prevent wear and chafing of the books and the breaking away of the leaves from each other and the cover; and to these ends it consists of a bracket provided with a series of rolls hung in a box, having a right-

angled plate united thereto by a web, substantially as hereinafter more fully set forth.

* * * * * * *

Wear, chafing, and other destructive effects to the books, besides the labor, etc., are greatly reduced by my improvements. As a rule, I place the books in the case directly upon the rollers, but, if desired, a supplemental shelf, C, may be employed, itself resting upon the rollers.

* * * * * * *

By sliding the books upon their sides into the case and upon the rollers all the advantages hereinbefore referred to as to the saving of the books and lessening of the labor in handling them are obtained.

CONANT PATENT OF 1885.

Patent to Conant (p. 148), No. 316,241, dated April 21, 1885, shows roller shelves, each consisting of a series of longitudinal parallel rollers forming the support for the book, the front rollers being placed forward of all portions of the framework so as to enable the book, when introduced upon or withdrawn from the shelf, to rest wholly upon such front roller without possibility of abrasion by contact with any other portion of the shelf or casing.

The specification states (p. 150):

> The rollers FF′ are made of a diameter a little greater than the thickness of the strips E and binding bars G, so that the books while being put into and removed from the bookcase will not come in contact with anything but the said rollers FF′, and will thus be prevented from being rubbed or marred by coming in contact with the stationary parts of the bookcase.

ADAMS' PATENT OF 1886.

Patent to Adams (p. 151), No. 338,459, dated March 23, 1886, shows a roller shelf provided with a series of parallel rollers for supporting the book, the front rollers being supported upon arms which are bent or carried back so as to per-

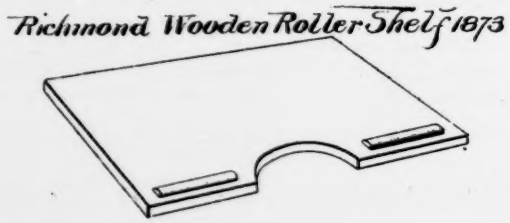
mit of the introduction of the hand between the front rollers and thus facilitate the insertion or withdrawal of the book without liability of contact of the fingers with any portion of the shelf or casing.

SHELVES IN COURT-HOUSE, RICHMOND, IND.

The evidence shows that there were in use at the court-house at Richmond, Indiana, in the year 1873, and thereafter, roller shelves for books, consisting of a wooden shelf having the ordinary hand hole at the front to enable the back of the book to be readily grasped and provided with rollers let into openings on each side of the hand hole for supporting the book and facilitating its introduction and withdrawal.

The existence of these shelves, and their use by the hundred, is testified to by M. R. Jewell (Q. 146, *et seq.*, p. 51), and also by Col. William W. Dudley (p. 70), who was clerk of the court at Richmond in 1873 and thereafter, and who was instrumental in having the shelves put in.

One of the original roller shelves, taken from the Richmond court-house, was offered in evidence as Defendant's Exhibit M. R. J. No. 1. The following sketch illustrates its construction:



ROLLER SHELVES COMPOSED OF PORTABLE OPEN METALLIC SUPPORTING FRAMES AND METAL ROLLERS.

The evidence also shows that prior to the date of the alleged Hoffman invention roller shelves composed of portable open metallic supporting frames and straight metal rollers extending from end to end of the frames were made and sold and used in large numbers and are still made and sold in competition with the Hoffman shelf.

One form of this prior shelf is shown in Fig. 16 of "Complainants Exhibit Office Specialty Manufacturing Company Catalogue" opposite p. 82, which is here reproduced.

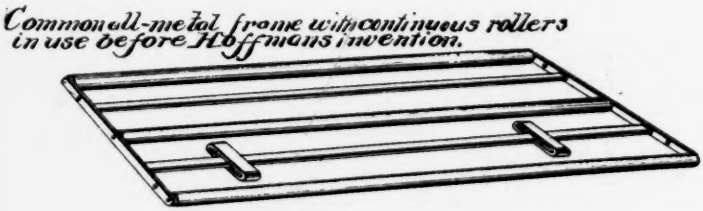


Fig. 16. Roller Book-Shelf, Style No. 3.

Mr. Freeman, plantiff's expert, testifies of this prior shelf as follows, (p. 11):

> Prior to the date of the Hoffman application, to-wit, February 12, 1887, it was common to use what were called roller shelves, the same consisting of frames or supports and longitudinal parallel rollers, which extended the entire length of the shaft and served to reduce friction in putting books upon and withdrawing them from the shelf. One form of such shelves is

shown in Complainants Exhibit Office Specialty Manufacturing Company's Catalogue on p. 14 thereof, Fig. 16.

Mr. Hine, the manager of the plaintiff corporation, testifying on the 3d of March, 1892, says as follows, (p. 31):

> I have been employed in the sale of metallic office fixtures, including shelving, for six years, and for four years have been engaged in the manufacture as well as the sale of such fixtures.
>
> At the time I became engaged in the business of selling office furniture and fixtures there were sold upon the market and put in and used, roller shelves having metallic frames and straight rollers extending the whole length of the shelf.

Again, (p. 38):

> X-Q. 19. At the time of the application of the Hoffman patent in suit portable roller shelves having rigid metal frames adapted to be screwed fast at their ends to the sides of the case were a common article of manufacture in various forms, are they not?
>
> A. I think they were. That might be qualified to a certain extent, as while roller shelves were common, roller shelves in which the rollers were supported by a frame independent of the upright were not very common.
>
> X-Q. 20. But prior to the application of the patent in suit shelves containing rollers having rigid metal frames adapted to be fastened to the sides of the case in practically the same manner that the shelf now in suit was fastened were sold in the market by different makers?
>
> A. Yes, sir.

RESUME OF THE PRIOR ART.

The prior art as developed by the above mentioned patents and proven prior uses therefore shows:

1. That it was not new at the date of the Hoffman invention to provide book shelves with rollers for sustaining the books and facilitating their entrance and withdrawal. This is shown

by the Harris, Boone, Wolfe, and Adams patents, the Richmond Shelf, and Defendant's Shelf, like Fig. 16 "Complainants Exhibit Office Specialty Company's Catalogue."

2. That it was not new to provide roller shelves with rollers placed at the front edges of the shelves so as to project above and in front the shelves. This is shown in the Boone, Conant and Adams patents and in the Defendants Shelves, like Fig. 16 of the aforesaid Exhibit Catalogue.

3. That it was not new to provide roller shelves with hand holes or recesses between the supporting rollers for the purpose of enabling the insertion of the hand to better grasp the book. This is shown in the Wolfe and Adams patents and in the Richmond shelf.

4. That it was not new to provide roller shelves with hand holes or recesses between front supporting rollers projecting above and forward of the edges of the shelves. This is shown in the Adams patent.

5. That it was not new in roller shelves to employ a wholly metallic open portable and attachable framework in connection with book supporting rollers made wholly of metal with the front rollers projecting above and forward of the edges of the shelves. This is shown in the defendants roller shelves, like Fig. 16 of Complainant's Exhibit Office Specialty Company's Catalogue, and is admitted by plaintiffs expert and by its general manager to be old, as hereinabove pointed out.

THE ALLEGED INVENTION OF HOFFMAN.

Notwithstanding this highly developed art, it is contended on behalf of the plaintiff that Hoffman made a great invention in roller shelves when he combined in one structure (1) a wholly metallic open, portable and attachable frame, (2) rollers mounted in said frame for supporting the books, the forward roller being supported and projecting above and in front of the front edge of the frame, and (3) a recess between the separated front rollers constituting a hand-hole for grasping the books.

There is not the slightest merit in this contention. Every element of the pretended new structure was old.

All the advantages of a wholy metallic frame were and are attained in the metal frame of the old metallic roller shelves in which a continuous front roller, without a hand-hole, are employed; all the advantages of separated front rollers were attained in the prior Adams shelf and in the prior Richmond shelf; and all the advantages of a hand-hole or recess for the fingers in grasping a book were attained by all prior shelves having hand-holes—from the plain wooden hand-hole shelf of antiquity, found in the desks and bookcases of our forefathers, of which this court will take judicial notice, to the hand-hole roller shelf of the Wolfe and Adams patents, and of the Richmond court house.

Hoffman didn't make any invention, he simply brought together in a single structure the old, well-known elements of prior structures. Given, the prior all-metal roller shelf like Fig. 16, of Defendant's Catalogue, with its attachability and detachability from its supporting case, with its all-metal frame, its metal rollers extending longitudinally from end to end of the frame and its front roller projecting above and forward of any part of the frame, and given, also the desirability of applying to such all-metal construction a hand-hole for the only purpose for which a hand-hole has ever been employed, *i. e.*, to enable the hand to be introduced, it is perfectly obvious that any skilled mechanic would have no difficulty in applying such a hand-hole to such a structure, and would do so by cutting out the middle portion of the front roller, suitably supporting the inner ends of the parts and utilizing the recess or space so left as the hand-hole, and this without the slightest exercise of the inventive faculty.

Hoffman occupied precisely the position of the skilled mechanic in the case supposed. Hand-holes and hand-holes for roller shelves were old and known to him, so were all-metallic roller shelves. He simply undertook to apply the old hand-

hole to the old all-metallic roller shelf, and in doing so did what it is obvious any other mechanic might and would have done without the exercise of anything more than the mere expected skill of his calling. He did nothing rising to the dignity of invention, and his patent is invalid under the rulings of this court in the following cases:

> Atlantic Works *vs.* Brady, 107, U. S. 192; Slawson *vs.* Grand Trunk R. R. Co., 107, U. S 649; King *vs.* Gallum, 109, U. S. 99; Double Pointed Track Co. *vs.* Two Rivers Mfg. Co., 109, U. S. 117; Estey *vs.* Burdett, 109, U. S. 633; Bussey *vs.* Excelsior Mfg. Co., 110, U. S. 131; Penn. R. R. Co. *vs.* Locomotive & Truck Co., 110, U. S. 490; Phillips *vs.* City of Detroit, 111, U. S. 604; Morris *vs.* McMillan, 112, U. S. 244; Hollister *vs.* Benedict & Burnham Mfg. Co., 113, U. S. 59; Thompson *vs.* Boisselier, 114, U. S. 1; Stephenson *vs.* R. R. Co., 114, U. S. 149; Mfg. Co. *vs.* Greenleaf, 117, U. S. 554; Gardner *vs.* Hurz, 118, U. S. 180; Pomace Holder Co. *vs.* Ferguson, 119, U. S. 335; Handy *vs.* Iron Works, 127, U. S. 370; Holland *vs.* Shipley, 127, U. S. 396; Plow Co. *vs.* Kingman, 129, U. S. 294; Brown *vs.* District of Columbia, 130, U. S. 87; Day *vs.* R R. Co. 132. U. S. 161; Marchand *vs.* Emken, 132, U. S. 201; Hill *vs.* Wooster, 132, U. S. 693; Busell Trimmer Co. *vs.* Stevens, 137, U. S. 423; McClain *vs.* Ostmayer, 141, U. S. 419; Mfg. Co. *vs.* Carey, 147, U. S. 623; Grant *vs.* Walter, 148, U. S. 547; Black Diamond Coal Mining Co. *vs.* Excelsior Coal Co., 156 U. S. 611; Richards *vs.* Chase Elevator Co., 158, U. S. 299.

THE CLAIMS OF THE HOFFMAN PATENT NOT FOR LEGITIMATE COMBINATIONS, BUT FOR MERE AGGREGATIONS OF OLD MECHANICAL FEATURES.

The claims of the Hoffman Patent are, in form, for combinations of parts, but the elements do not in fact combine, in a patent law sense. They are merely aggregated, and perform their old functions, and only their old functions, in the same

old way. This is self-evident. The open, all-metal frame is light and ventilated as in prior structures, unmodified by the presence of the hand space, the rollers perform their old function of preventing abrasion and facilitating the entry and removal of books, and the hand space, just as always, affords opportunity for the fingers to take a firmer grasp on the back of the book. The front rollers operate precisely the same, whether the hand space be present or absent. Remove the rollers and the hand space will function as before. Neither modifies the other; each performs its alloted duty, whether or not the other be present.

To say that the hand space is combined with the rollers because it enables the fingers to be thrust back of the rollers, is misleading. The real object of the hand space in this aggregation is to enable the fingers to obtain a firmer grasp on the back of the book—the passing of the fingers beyond the plane of the rollers being merely incidental.

That a mere aggregation is not patentable is a proposition that does not, in this court, require the support of any argument.

> Hailes *vs.* Van Wormer, 20 Wall., 353–368; Reckenderfer *vs.* Faber, 92 U. S., 347–356; Phillips *vs.* City of Detroit, 111 U. S., 604; Brinkerhoff *vs.* Aloe, 146 U. S., 515–517; Palmer *vs.* Village of Corning, 156 U. S., 342–345; Richards *vs.* Elevator Co., 158 N. Y., 299–302.

This argument was addressed to Judge Wheeler in the Chase suit and was found by that learned judge to be sound and, in view of it, he declared the Hoffman claims invalid.

He said (84 Fed., 893):

> This case was before this court, held by Judge Lacombe, on a motion to dissolve an injunction, and the patent was then much considered, 73 Fed., 831. Not much more has been made to appear new and little more seems necessary to be said. The hand recess was well known before Hoffman's supposed invention, and its use

is the same in one form as in another of such a book-case. Rollers were known for relieving the books and their supports from friction, and so were rollers at each side of room for handling the books. Rollers at each side of the hand recess in front of and above the frame may be new in that exact position, but they operate there as such rollers had done before, and no differently because of any relation to the hand recess formed of the frame. There does not seem to be any new working combination in either of these claims. Bill dismissed.

IF VALID AT ALL THE PATENT IN SUIT IS AN EXCEEDINGLY NARROW AND LIMITED ONE.

The patent itself and the history of the application for it show, conclusively, that the invention covered by the first and second claims if invention at all, is of the narrowest possible description. In the preamble to the specification the patent says (p. 101):

> The object of my invention is to facilitate the handling and preventing the abrasion and injury of heavy books, etc. It consists essentially of the *peculiar arrangement* of the guiding and supporting rollers and of the *peculiarities in the construction of the casing and shelves hereinafter specifically set forth.*

This is clearly not a statement respecting a pioneer or basic invention, but a general description of a very narrow invention whose novelty resides in "peculiarities" of construction such as are "specifically" set forth further on in the patent.

The two claims of the patent alleged to be infringed are as follows (p. 102):

> 1. In a storage case for books, etc., the combination of a supporting rack or shelf composed of metallic strips and having a re-entrant bend or recess in its front edge and rollers journaled in said rack and projecting above and in front of the same on each side of said bend or recess; substantially as described.
>
> 2. In a book shelf, the combination of a supporting frame, a series of horizontal rollers, the front roller in

two separate sections, the intermediate part of the frame being carried back to permit the admission of the hand between said roller sections; substantially as described.

It will be noted that in the first claim the shelf is described as being composed "of metallic strips and having *a re-entrant bend or recess in its front edge*," while in the second claim the same peculiar construction is referred to by the phrase "the intermediate part of the frame being *carried back* to permit the admission of the hand between said roller sections."

This re-entrant bend or carried back portion of the frame is referred to in the body of the specification as follows (p. 102):

> The middle U-shaped section c^2 is attached at its ends to the rear section c and extends from the back to the front of the case, parallel with the sections c^1, c^1, and forms the center of the front side of the frame, which is bent inwardly at c^4, thus exposing a portion of the book to the grasp and facilitating its removal from the case.

It appears from the file wrapper and contents of the application for the Hoffman patent (a copy of which is in evidence) that Hoffman at first conceived himself to be entitled to broader claims than were ultimately granted him.

For instance, some of his original claims read as follows (p. 85):

> 1. In a storage case for books, etc., a supporting shelf or rack provided with a roller the face of which projects beyond the edge of said shelf or rack; substantially as and for the purpose set forth.
>
> 2. In a storage case for books, etc., supporting racks each composed of a roller frame and rollers mounted therein projecting above and below said frame; substantially as and for the purpose set forth.
>
> 3. In a storage case for books, etc., supporting racks each composed of a frame formed with a re-entrant bend or recess in its front edge and rollers mounted in said frame; substantially as and for the purpose set forth.

4. In a storage case for books, etc., a rack composed of a frame formed of the back section c, side sections c^1, c^1, middle U-shaped sections c^2 having a re-entrant bend in front, and cross sections c^3, c^3 connecting the sections c^1, c^1 and rollers journaled in said frame, substantially as and for the purpose set forth.

5. In a storage case for books, etc., a shelf or rack having one or more recesses in its front edge and a roller or rollers set in said recess or recesses with its working face projecting beyond the front edge of said shelf or rack; substantially as described and for the purpose set forth.

8. In a storage case for books, etc., a portable cabinet or case, shelves or racks vertically adjustable in said case and rollers mounted in said shelves or racks; substantially as and for the purpose set forth.

These claims were rejected on the patent to Conant No. 316,241 (p. 87), whereupon they were stricken out and the following claims were introduced by an amendment of November 22, 1887, viz (p. 87):

1. In a storage case for books, etc., the combination of a vertically adjustable supporting shelf or rack and the roller journaled in said shelf or rack and projecting beyond the front edge thereof; substantially as and for the purpose set forth.

3. In a storage case for books, etc., the combination of a rack composed of metallic strips and supporting rollers journaled in and projecting above said rack; substantially as and for the purpose set forth.

8. In a storage case for books, etc., the combination of a supporting rack or shelf composed of metallic strips and having a re-entrant bend or recess in its front edge and rollers journaled in said rack and projecting above and in front of the same on each side of said bend or recess; substantially as and for the purpose set forth.

These claims were rejected on Conant No. 316,241; Adams No. 338,459, and others, and were thereupon cancelled.

From these actions on the part of the Patent Office, followed

by applicant's acquiescence in them, it is clear that it was only intended that Hoffman's protection should be of the most limited character and confined to a roller shelf having a re-entrant bend or recess in its front edge formed by carrying back an intermediate part of the frame.

Further support to this view is found upon examination of the records of the interference that took place in the Patent Office between the Hoffman application and the application of Jewell & Yawman.

This interference was declared on the 25th day of October, 1889, upon the following issue, as appears from "Complainant's Exhibit B," introduced by plaintiff, viz (p. 96):

INTERFERENCE ISSUE.

> In a book shelf the combination of a supporting frame, a series of horizontal rollers carried thereby, a front roller formed in two separate sections, the intermediate part of the frame being carried back to permit the admission of the hand between the roller sections.

The alleged interfering structure that was shown in the Jewell & Yawman application is represented in Jewell & Yawman Drawing, (p. 135), and is substantially the same as represented in "Exhibit O. S. Mfg. Co. Catalogue, Figure 17" (p. 82). The claim of Jewell & Yawman and the claims of Hoffman that were alleged to constitute interfering claims are quoted in the decision of the Examiners-in-Chief, on appeal (a copy of which has been offered by the plaintiff as "Complainant's Exhibit D"), and reads as follows (p. 106):

Jewell & Yawman's Claim.

> In a portable roller book shelf, the combination of a rigid portable supporting frame, a series of rollers therein, the front roller divided centrally into two coincident sections, and supported by a retreating bar or support *e*, whereby the admission of the hand between the roller sections is permitted to grasp the book.

Hoffman's Claims.

> In a storage case for books, etc., the combination of a supporting rack or shelf composed of metallic strips and having a re-entrant bend or recess in its front edge, and rollers journaled in said rack and projecting above and in front of the same, on each side of said bend or recess; substantially as and for the purposes set forth.
>
> In a book shelf, the combination of a supporting frame, a series of horizontal rollers, the front roller in two separate sections, the intermediate part of the frame being carried back to permit the admission of the hand between the roller sections; substantially as described.

(Note: These Hoffman claims correspond to the two claims in suit.)

The history of the interference shows that each of the tribunals that passed upon the case regarded the invention in dispute as a very limited one and as restricted to a structure having, technically, a front bar that was bent back or provided with a re-entrant bend, and negatives absolutely the plaintiff's contention that the invention was not so restricted.

In the decision of the Examiner of Interferences (Exhibit C in this cause) (p. 103) there is a discusion of an exhibit that was offered by the claimants, Jewell & Yawman, in support of the issue, but which was ruled out by the Examiner as not being pertinent.*

The Examiner of Interferences said, (p. 104):

> It will be observed from an inspection of the 1886 shelf exhibit that *the front bar of the frame is straight* with short rollers projecting from its front side at or near each end. Such a construction, of course, leaves a space between the rollers in front of the bar, which will permit the admission of the hand when withdrawing a a book from the shelf.

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* [Note: The exhibit shelf here referred to was not offered in evidence in this suit but it is illustrated in Figs. 1 and 2 of the Jewell & Yawman application found opp. p. 120.]

> It is, however, submitted that no part of the frame is *carried back* to affect this purpose. It is true that the whole frame is back of these two roller sections and in that sense the intermediate part is "carried back" of them, inasmuch as it is carried by the remaining portion of the frame of which it forms a part.
>
> The construction of the issue insisted upon by counsel is believed to be without warrant. A careful reading thereof, it is thought, does not justify it, nor is the Examiner of the opinion that the Primary Examiner, in view of the state of the art, as cited by him while considering the applications here involved, proposed to frame an issue that would be comprehended in a shelf that had a frame with a straight bar having a roller in front, in two separate sections with a space between them. In the Hoffman application, he cites the patent to Adams No. 338,457, March 23, 1886, and certainly he would not declare an interference upon an issue which, if construed as the counsel insists, would be squarely anticipated by it.

In the decision of the Board of Examiners-in-Chief, on appeal (Exhibit D in this cause), the Board said (p. 106):

> From the state of the art as shown in the record and evidence it is evident that only extremely limited and specific claims could be maintained by either party, and such was the view taken by the Primary Examiner. *The issue must, therefore, be strictly construed to embrace literally every specific feature as set forth by the parties in the combination claimed by each.*

Then, after reciting the claims of the respective parties, the opinion goes on to say (p. 107):

> We must consider the "*retreating bar or support e*" an essential feature, and it is so considered by the Examiner in allowing the claim thus specific and limited to stand and go into interference with the Hoffman claims resting on the "*carrying back*" *of the front part of the frame* between the rollers, both being for precisely the same purpose and substantially of the same construction.

Then further on, in speaking of the Jewell & Yawman exhibit having the straight front bar, the opinion proceeds (p. 107):

> It lacks the series of horizontal rollers as set forth and shown and claimed by both parties and embraced in the issue, and has no "intermediate part of the frame" *carried back* to permit the admission of the hand between the roller sections. But instead thereof, there are but three short rollers, one in the extreme rear and two in front, journaled in brackets attached to flat bars which constitute the frame, there being a wide space between the inner ends of the front rollers which are in close contiguity to the front flat bar of the frame, which is straight and forms the "intermediate part between the front rollers," *and is not "carried back"* or *curved* and *has no re-entrant bend or recess in its front edge* to permit the admission of the hand between the roller sections.

When the case came on before the Commissioner of Patents, in person, on appeal, he affirmed the decision of the lower tribunals and said (Exhibit E in this cause) (p. 109):

> A book shelf, in order to contain the combination embraced in the issue must have the following features: (1) a supporting frame, (2) a series of horizontal rollers carried thereby, and (3) a front roller formed in two separate sections, *the intermediate part of the frame being carried back to permit admission of the hand between the roller sections.* These elements are contained in the interfering claims of both parties, *and in view of the prior art*, as developed in the evidence, *the issue must be limited so as to require all of the specific elements mentioned.*

Further on, the Commissioner says, in speaking of the 1886 shelf set up by Jewell & Yawman as containing the invention in issue (p. 110):

> I agree with the Examiners-in-Chief, that *exhibit Jewell & Yawman 1886 shelf does not have the intermediate part of the frame carried back to permit the*

> *admission of the hand between the roller sections, neither does it have the front roller divided centrally into two coincident sections, and supported by a retreating bar or support e,* as set forth in the Jewell & Yawman claim involved in the interference.

From this history of the career of the Hoffman application in the Patent Office, it appears, first, that the carrying or curving back of the front bar of the shelf frame, or in other words, the forming of the re-entrant bend in the front bar of the Hoffman frame was regarded as constituting the very gist and essence of the invention, and it is clear that unless this limitation had been imposed upon the Hoffman claims they would never been granted.

It is further evident from this history that the Patent Office *did not* consider a frame that had a *straight front bar* and separate rollers supported thereon as containing the Hoffman invention. Hoffman's assignee, the plaintiff in this cause, cannot now be heard to say that such limitations are immaterial and may be disregarded.

In Roemer *vs.* Peddie, 132 U. S., 315, this Court said:

> This court has often held that where a patentee on the rejection of his application inserts in his specification in consequence limitations and restrictions for the purpose of obtaining his patent, he cannot after he has obtained it, claim that it shall be construed as it would have been construed if such limitations and restrictions were not contained in it.

Again, in Sargent *vs.* Hall Safe and Lock Co., 114 U. S., p. 63, the court said:

> In patents for combinations of mechanism, limitations, and provisos imposed by the inventor, especially such as were introduced into an application after it has been persistently rejected, must be strictly construed against the inventor and in favor of the public, and looked upon as in the nature of disclaimers.

Again, in Sutter *vs.* Robinson, 119 U. S., 530:

> He (the patentee) is not at liberty now to insist upon a construction of his patent which will include what he was expressly required to abandon and disavow as a condition of the grant.

Again, in Royer *vs.* Coupe, 146 U. S., 524:

> It is well settled by numerous cases in this court, that a patentee cannot successfully contend that his patent shall be construed as if it still contained the claims which were so rejected and withdrawn.

See also:

Leggett *vs.* Avery, 101 U. S., 256.
Vulcanite Co. *vs.* Davis, 102 U. S., 222.
Fay *vs.* Cordesman, 109 U. S., 408.
Mahan *vs.* Harwood, 112 U. S., 624.
Shepard *vs.* Carigan, 116 U. S., 593.
White *vs.* Dunbar, 119 U. S., 47.
Bragg *vs.* Fitch, 121 U. S., 478.
Snow *vs.* Railway Co., 121 U. S., 617.
Crawford *vs.* Heisinger, 122 U. S., 589.
Phœnix Caster Co *vs.* Speigel, 133 U. S., 360.
Yale Lock Co. *vs.* Berkshire Nat. Bank, 135 U. S., 343.
Dobson *vs.* Lees. 137 U. S., 258,
National Hat Pouncing Mach. Co. *vs.* Belden, 147 U. S., 482.
Morgan Envelope Co. *vs.* Albany Co., 152 U. S., 425.

The Court of Appeals quite missed the point as to the bearing of the Jewell and Yawman 1886 shelf. They say (p. 311):

> Some of the inventions most relied on as anticipations of the invention claimed by the plaintiff will now be noticed.
>
> (1.) The Jewell and Yawman experiment of 1886 need not be described. In all the decisions made in the interference proceedings between defendant, as their assignee, and the plaintiff herein, that was found to be nothing more than an incomplete and abandoned experiment. There is no testimony to warrant us in coming to a different conclusion.

This 1886 shelf was not set up in this suit as an anticipation of the plaintiff's patent, but merely for the purpose of throwing light upon the proper construction to be given that patent by showing that the device which it embodies, though falling clearly within the Hoffman claims, as the plaintiff would now have them construed, was regarded by the Patent Office when the case was there as not embraced by such claims, and for that reason held not to be pertinent evidence. Had the Patent Office been persuaded that the 1886 shelf was within the interference issue, Hoffman might never have obtained his patent.

THE THIRD CLAIM OF THE HOFFMAN PATENT IN SUIT NEGATIVES ANY BROAD CONSTRUCTION OF CLAIMS 1 AND 2.

Through some inadvertence, Hoffman was granted the third claim of his patent. This claim is a broad one and apparently covers what plaintiff now insists the first and second claims cover. It reads as follows (p. 103):

> 3. In a roller shelf, a frame with a hand-hole at the front to permit the hand to pass back of the forward bar and with the forward supporting rollers at opposite sides of said hand-hole; substantially as described.

It will be observed that there is no limitation in this claim to any *carrying back* of the frame or to any *re-entrant bend* in the frame, but the language is broad enough to cover any frame having a hand-hole at the front formed to permit the hand to pass back of the forward bar.

But so clearly invalid is this claim, in view of the prior art, that plaintiff has not had the temerity to put it in issue in this cause. It has never been brought to the judgment of the court. If it had been, it would have been declared invalid. *So long, however, as it stands in the patent, it completely negatives any construction of the first and second claims that disregards the*

precise limitations expressed in these claims as to the carrying back of the front bar of the frame or the forming of a re-entrant bend in said front bar.

JUDGE LACOMBE HELD THE HOFFMAN PATENT TO BE EXCEEDINGLY NARROW.

In his opinion in the Chase suit (Fenton Metallic Mfg. Co. *vs.* Chase, 73 F. R., p. 831,) Judge Lacombe thus construed the Hoffman patent:

> The patent is No. 450,124, to Horace J. Hoffman, April 7, 1891, for improvements in storage cases for books. As stated in the patent, the object of the invention is "to facilitate the handling and prevent the abrasion and injury of heavy books, etc. It consists, essentially, of the peculiar arrangement of the guiding and supporting rollers and of the peculiarities in construction of the case and shelves hereinafter specifically set forth." It is unnecessary to discuss the details of the patent, or to enter into any elaborate disquisition on the state of the art. That may be more appropriately left for final hearing. Where the validity of a patent is attacked, and there is not a clear preponderence in its favor, injunction *pendente lite* should not issue. Not only has the complainant no clear case, but, on the contrary, it is difficult to see on what ground it can be seriously contended that there is patentable novelty warranting such a construction of the patent as would cover defendant's structure. Roller-shelf book cases were old. So, too, it was old to provide such shelves with a roller or rollers arranged in front of the edge of the shelf, so as to facilitate the insertion and removal of a heavy book without friction or abrasion. Stripped of all verbiage, the sole improvement of the patentee germane to the structures now before the court consisted in so arranging the front edge of the shelf as to provide a re-entrant bend or recess therein, so that the hand could be inserted a greater or less distance back from the line of the front edge, and the book seized hold of. The evidence shows, and certainly without any proof it is common knowledge, that so-called "hand-holes" in the front of book shelves have been used for very many

> years before the patent was applied for. It is true that these "hand-holes" or "re-entrant recessses" had been provided only in the old fashioned wooden shelves unprovided with rollers, * but when skeleton frame roller shelves had come into use it seems a rather startling prosposition to advance that it required inventive genius to provide them with the same sort of "hand-holes" to perform the same function. There might be some mechanical ingenuity warranting a patent for the details of the structure, but to hold defendant as an infringer the patent must be construed so broadly as to cover the recess or hand-hole generally, whether it be rounded or square, formed by a bending in of the front bar of the frame, or by protruding rollers on brackets to the right and left of the recess beyond the front bar.

There can be no doubt after reading this language that Judge Lacombe conceived the patent in suit to be limited, *if sustainable at all* (which even at that preliminary stage of the litigation he doubted), to a shelf just such as was illustrated in the patent, and to not cover a shelf with a straight front bar and brackets applied thereto to sustain the front rollers.

THE ALLEGED INFRINGING DEVICES.

Having now examined the Hoffman patent in the light of the prior art and of the proceedings in the Patent Office before its issuance, and having ascertained the narrowness of Hoffman's invention, if invention it was, and the limited and restricted character of claims 1 and 2 of the patent, we will briefly discuss the alleged infringing structures made by defendant.

For the convenience of the court we have had drawn on a separate sheet annexed to this brief views of the several devices that have been referred to as antedating the Hoffman invention, a view of the Hoffman shelf, a view of the shelf made by the defendant like "Office Specialty Mfg. Co.'s Catalogue, Figure

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*The learned judge evidently was not apprised of the fact that wooden shelves with rollers, like the RichmondShelves, were also old in the art.

17," a view of the shelf made by defendant like "Exhibit Hansmann's Sketch," a view of defendant's New No. 4 Shelf, a view of "Jewell & Yawman's 1886 Shelf," which was held by the Patent Office not to be covered by the Hoffman claims, and a view of the shelf of the Jewell & Yawman patent owned be defendant and under which its New No. 4 Shelf is made.

DEFENDANT'S SHELF LIKE "OFFICE SPECIALTY MFG. CO.'S CATALOGUE, FIGURE 17."

The shelves made and sold by defendant like "Exhibit O. S. Mfg. Co.'s Catalogue, Fig. 17," were made precisely in accordance with the shelf illustrated in the Jewell & Yawman application which was in interference with the Hoffman application in the Patent Office (see Fig. 3, Drawing of Jewell & Yawman Application, opposite p. 135.) When the Hoffman patent was issued, shelves of this kind ceased to be manufactured by the defendant. The proofs show that only twenty-five (25) of these shelves were sold after the Hoffman patent issued. Whether, assuming it to have any validity at all, even when limited to Hoffman's precise structure, the Hoffman patent could be construed to cover defendant's shelves of this description, may well be questioned, but because of the fact that Jewell & Yawman, the defendant's assignees, had contended for priority of invention in respect of an issue calling for *an intermediate part of the frame carried back*, the court below being of opinion that the patent was valid, was constrained to give the plaintiff the benefit of any doubt as to this particular device of the defendant having such a carried back frame, and held it to be within the patent.

DEFENDANT'S SHELVES LIKE "EXHIBIT HANSMANN'S SKETCH."

After the decision in the interference case and the issuance of the Hoffman patent in suit, defendant ceased making shelves

like "O. S. Mfg. Co.'s Catalogue, Fig. 17," (p. 82) and began making shelves like "Exhibit Hansmann's Sketch" (p. 159). In these latter shelves, the front bar of the metal frame was made *straight* and the front rollers on opposite sides of the hand-hole were supported at their inner ends by individual brackets bolted to the front face of the straight bar of the frame and at their outer ends by extensions formed on the end bars of the frame. This construction was adopted both because it did not embody a supporting rack or shelf "having a re-entrant bend or recess in its front edge" nor "the intermediate part of the frame carried back," called for by claims 1 and 2 of the Hoffman patent, and because it was closely analogous to the form of roller shelf shown in "Jewell & Yawman's Exhibit 1886 Shelf, (Fig. 1, p. 126)," which the several tribunals of the Patent Office had decided did not fall within the Hoffman claims, since it had a *straight* front bar, instead of a front bar with a re-entrant bend or curve, and brackets for the front rollers applied to said *straight* bar.

It would seem, at first blush, that the difference between the shelves made in accordance with "Exhibit Hansmann's Sketch" and those made in accordance with "Exhibit O. S. Mfg. Co.'s Catalogue, Figure 17," was not very great and to consist merely of the cutting of the curved bar which supported the inner ends of the front rollers in the latter structure into two parts, but it must be remembered that in the shelves made in accordance with the illustration in the catalogue *the front bar itself, as well as the bar which supports the inner ends of the front rollers, was bent back* and that the difference between the device of the patent in suit and the device shown in the catalogue became thus increased and magnified in the shelves made like "Exhibit Hansmann's Sketch." The same reason therefore, for holding that the construction shown in the catalogue was within the claims of the patent in suit, *i. e.*, because such structure was the one directly involved in the Patent Office interference, did not obtain when considering the question of

infringement in connection with the shelves like Exhibit Hansmann's Sketch.

Our contention is, first, that a shelf like "Exhibit Hansmann's Sketch" should not be held to infringe the patent in suit because that identical form of shelf was not involved in the Patent Office interference; secondly, because said form of shelf does not have a re-entrant bend or curve in the front bar of its main frame; thirdly, because said form of shelf is of the type of the Jewell & Yawman Exhibit 1886 Shelf, decided by the different tribunals of the Patent Office in the interference case to not fall within the issue of the interference or the Hoffman claims; and fourthly, because such form of shelf was held by Judge Lacombe not to be within the patent. Judge Lacombe said (page 832, 73 F. R.):

> There might be some mechanical ingenuity warranting in a patent for the details of the structure, but to hold defendant as an infringer the patent must be construed so broadly as to cover the recess or hand-hole generally, whether it be rounded or square, formed by a bending-in of the front bar of the frame, or by protruding rollers on brackets to the right and left of the recess beyond the front bar.

The learned judge refused to give such a construction to the patent.

DEFENDANT'S NEW NO. 4 SHELF.

After the interlocutory decree in this cause enjoining defendant specifically from making shelves like "Exhibit O. S. Mfg. Co.'s Catalogue, Fig. 17" and "Exhibit Hansmann's Sketch," defendant began the manufacture of what is known as the "New No. 4 Shelf" (bottom figure opp. p. 233). This shelf Judge Cox held was not properly before the court and ruled out all findings of the Auditor in respect thereto (p. 299), but he, in turn, was reversed by the Court of Appeals, and the finding of the Auditor approved. (p. 318).

In this New No. 4 Shelf the *front bar* of the frame is made

perfectly straight and each of the rollers is supported *at both its ends* in a separate bracket or hanger, which is, in turn, bolted to the aforesaid front flat bar of the frame. There is no curving back of the frame, there is no re-entrant bend in the frame. There is, it is true, a space on hand-hole between the front rollers, but such a space is not claimed broadly in claim 1 or 2 of the patent in suit, nor could it rightfully have been made the subject of a claim by Hoffman, in view of the prior Adams patent, or of the prior Richmond shelf.

The New No 4 Shelf is clearly like the Jewell & Yawman 1886 shelf (p. 126, Fig. 1) held by all the tribunals of the Patent Office not to be within the Hoffman claims in suit, and is therefore such a structure as the Patent Office intended should *not* be covered by said claims.

THE GRANTING OF THE JEWELL & YAWMAN PATENT NO. 557,392, UNDER WHICH DEFENDANT MAKES THE NEW NO. 4 SHELF, SUPPORTS DEFENDANT'S CLAIM OF NON-INFRINGEMENT.

Since the grant of the Hoffman patent in suit a patent has been granted to the defendant, as the assignee of Jewell & Yawman, covering defendant's New No. 4 Shelf. This patent is No. 557,392 and is dated March 31, 1896 (p. 157).

Now, it has many times been decided that where the patentee of a mere improvement in an art sues the user of another patented improvement, the circumstance that the defendant has a patent for his structure tends to prove lack of identity of structure and to negative the charge of infringement. This is a reasonable doctrine and is founded upon the assumption that if the defendant's device had been considered the same as, or an equivalent for, the device of the plaintiff, the defendant's patent would not have been granted. In other words, the grant to defendant is evidence of a substantial difference between his device and that of the plaintiff.

In Boyd *vs.* Janesville Hay Tool Co., 158 U. S., 260, the Supreme Court of the United States, quoting from an earlier opinion of Mr. Justice Strong, on the circuit, said:

> The grant of the letters patent (to the defendant) was virtually a decision of the Patent Office that there is a substantial difference between the inventions. It raises the presumption that, according to the claims of the later patent, this invention is not an infringement of the earlier patent.

See also—

Corning *vs.* Burden, 16 How. 265.

HOFFMAN HAVING INVENTED BUT A SPECIFIC IMPROVEMENT, IF HE INVENTED ANYTHING AT ALL, CANNOT INVOKE THE DOCTRINE OF EQUIVALENTS.

Hoffman's invention, as we have seen, was at the very most a mere specific improvement over pre-existing roller shelves. He did not originate the idea of roller shelves, nor of roller shelves with hand-holes. If he invented anything, which Judge Lacombe seriously doubts and Judge Wheeler denies, it was the *specific form* of his particular shelf.

Being then a mere improver, he is not (nor is his assignee), under the authorities, entitled to invoke the doctrine of equivalents, but must be restricted to his own peculiar structure.

McCormick *vs.* Talcott, 20 How , 305.
Burr *vs.* Duryea, 1 Wall., 531.
Bragg *vs.* Fitch, 121 U. S., 478.

Upon the foregoing showing, we submit that the bill in this cause should be dismissed, on the ground, if for no other reason, that neither of the defendant's shelves embodies the subject matter of claims 1 or 2 of the patent in suit construed limitedly as the latter must be to be sustainable if they are sustainable at all.

THE AUDITOR'S REPORT.

The Auditor found that the plaintiff had suffered no damages by reason of defendant's infringements, and as the plaintiff took no exceptions to this finding further consideration of the question of damages is unnecessary.

At the request of the defendant, the Auditor made separate findings in respect to the profits made by the defendant from the sale of the several kinds of shelves it manufactured. The number of findings required by following such a course accounts for the multiplication of exceptions.

The Auditor found that claims 1 and 2 of the patent in suit are for a roller shelf; that the defendant is not a manufacturer but buys its goods already made; that in some instances shelves alone, as separate articles have been made for defendant and have been sold by defendant without association with other devices or structures; that in the majority of instances, however, the shelves made for and furnished to the defendant have been purchased in connection with cases adapted to contain and support them; that in the majority of instances the shelves sold by defendant have been sold in association or in combination with cases; that where shelves associated with cases have been purchased by the defendant, the defendant is entitled to a deduction for the cost of the cases; that where shelves have been sold by the defendant in association with cases the defendant is entitled to a deduction from the price received equal to the value of the cases. The Auditor further found that as the purchase and sale of roller shelves forms but a fractional part of defendant's whole business, the defendant is entitled to an allowance for a proportionate part of the general expenses of the business in arriving at the net profits realized from the sale of the shelves.

The defendant's exceptions to the Auditor's report do not question the number of shelves of different styles purchased by defendant or the number sold by defendant, nor do they ques-

tion the amount of deduction (50 per cent.) from the *selling price* of combined shelves and cases *due to the cases* constituting parts of such combinations; but they do question the propriety of the Auditor's findings as to the prices paid by defendant for the shelves as such and as to the prices received from the sale of the shelves as such.

THE EXCEPTIONS TO THE AUDITOR'S REPORT.

The defendant's exceptions to the Auditor's report will now be separately examined.

FIRST EXCEPTION.

> *First Exception.*—For that the said Auditor in his said report found that the shelves of the form and description illustrated in "Exhibit O. S. Mfg. Co.'s Catalogue, Fig. 17," and of the form and description illustrated in "Exhibit Hansmann's Sketch," were sold by the defendant at an average price of $2.27 per shelf in combination with cases, whereas he should have found that he was unable to ascertain what was the average selling price of said shelves in combination with cases and that there was no competent evidence from which to determine such average selling price.

The error pointed out by this exception is the Auditor's assumption that the average selling price of the shelves in combination with cases was $2.27 per shelf and case. He rejects as unreliable the estimates of defendant's General Manager contained in the statement of September 15, 1893 (p. 234), and bases his finding entirely upon the schedule of prices contained on page 228. If defendant had adopted a regular schedule price and had adhered to the same in selling its goods, the Auditor might, perhaps, have been justified in taking such schedule price as a basis for his computation; but the evidence is that this schedule was one that was furnished to defendant's agents and salesmen as a mere general guide and was not by any means strictly followed.

All the testimony on the subject of the schedule prices comes from Mr. Lomb, General Manager of defendant corporation. He testifies as follows (p. 176):

> Q. Did you not furnish your agents and managers with a standard schedule or list prices at which certain goods would be sold under ordinary circumstances, so that if a party wrote to one of your managers and asked the price of your 21-inch No. 4 Shelves he would have a standard from which to give his answer?
>
> A. We have such schedule *but the price at which the goods were to be sold was left to the discretion of the agents or managers.*
>
> Q Was that a printed or written schedule furnished each agent?
>
> A. It was typewritten.
>
> I want to get your own estimate as to the price at which the shelves should be sold, and this is what I referred to when I asked you to produce that schedule, you will, therefore, understand now what it is that I want to be produced here.

Page 179, by Mr. Foster:

> Q. You referred to the fact that while you had a normal price for certain articles your agents were instructed that they might sell at lower prices under certain circumstances, I understand that these circumstances arose from competition, and they were instructed that if they had to enter into competition with other parties that they might offer the goods at lower prices for the sake of effecting the sale, was that so?
>
> A. Yes, sir; but at the same time we have many instances where we do not have competition and rather than create a competition or make the would-be purchaser write for other estimates, *the job would be closed at 10 or 15 per cent. lower rather than to get that competition in.*

Page 180:

> You have heretofore been requested to produce a schedule of prices such as you furnished your agents with for the purpose of guiding them as to the prices to be asked for shelves of the character to which you have

testified. If you have said schedule, produce the same and mark it with your initials.

A. I here produce schedule of prices of roller shelves marked with my initials. Prices include the cases. Proportion of shelves which we sell without cases as compared with those we sell with cases is as 9 to 110.

(Schedule thus produced is offered and put in evidence and marked "Exhibit Defendant's Schedule of Shelf Prices."

Page 181:

You have stated that your agents were instructed that they might sell at lower than the schedule prices and you have produced memoranda showing the number of shelves disposed of to the agents and the amounts charged them. Please state the percentage of reduction below the schedule price, or the prices mentioned in the memoranda, that was actually made in settling with your agents, so far as you can with certainty fix it. This is, assuming the total amount charged to your agents in the said memoranda to have been so much, and the total amount paid by your agents in settlement of accounts to have been so much, what would have been the percentage of difference between the two accounts so far as you are able to determine it?

A. As goods are mostly sold in competition and many times at considerable reduction, it is impossible to state with any degree of certainty the price received for them. Shelves are in almost every case furnished with other work.

On page 181 appears the "Exhibit Defendant's Schedule of Shelf prices" introduced after the quoted answer, p 180. It reads as follows:

SCHEDULE OF PRICES OF ROLLER SHELVES IN CASES.

(Either straight or divided front roller).

20x4½ x14 in. or less in width or depth	$2.20	$2.40
24x4½ x16 in. " " "	2.50	2.65
30x5 x20 in. " " "	3.00	3.25
Over 30 in. wide, in quanties of 20 or less	5.00	5.50

Page 228:

State the regular price at which you sell and have sold shelves of different sizes alone and apart from cases.

A. I submit herewith schedule of prices of shelves with and without cases, which we adopted about a year ago for a guidance of our salesman, *but it is not always adhered to in actual practice.*

Schedule submitted in connection with the above answer reads as follows:

ROLLER BOOK SHELVES—with Cases—

20 in. wide x 14 in. deep or less	$2.25
20 in. " x 17 in. " " "	2.35
20 in. " x 20 in. " " "	2.50
20 in. " x 24 in. " " "	2.60
24 in. " x 17 in. " " "	2.50
24 in. " x 20 in. " " "	2.60
24 in. " x 24 in. " " "	2.75
24 in. " x 30 in. " " "	3.00
30 in. " x 17 in. " " "	3.00
30 in. " x 20 in. " " "	3.25
30 in. " x 24 in. " " "	3.50
30 in. " x 24 in. " " "	3.75
30 in. to 40 in. wide, without regard to depth,	4.75
Over 40 in. wide	6.00

ROLLER BOOK SHELVES—without Cases—deduct 40 per cent.

The above is substantially all the evidence relating to the schedule prices from which the Auditor deduces an average selling price of $2.27 per shelf in combination with cases.

By just what process he arrives at this conclusion we are not informed. He certainly must have done a good deal of guessing to arrive at such a result. Not only does he guess as to the figures, but he assumes that either of the schedules produced was in operation during the whole period of the account-

ing, that is to say, between the time of bringing the suit in 1893 to September 1, 1896.

In order that a plaintiff may recover profits of a defendant, in a patent case, it is necessary that he show the *actual profits* that the defendant made, not the profits that he might have made or should have made, but the profits that he actually did make, and this must be established by certain and explicit evidence. Speculation and conjecture are not to be indulged in.

Tilghman *vs.* Proctor, 125 U. S. 136.
Garretson *vs.* Clark, 111 U. S. 120.

The proofs clearly show that the so-called schedule price was not adhered to—was only a general guide. Even the Auditor recognizes this, for he holds, in effect, that if there was any departure from the schedule price it was the duty of the defendant to show it; that the burden of proof is upon the defendant. This is not the law. The burden of proof in the ascertainment of both damages and profits in a patent case is upon the plaintiff.

Keystone Mfg. Co. *vs.* Adams, 151 U. S., 139.
Seymour *vs.* McCormick, 16 How., 480.

The Auditor evolves a schedule price which the proofs show was not followed and then places the burden of proof upon the defendant to show the instances in which it was not followed. What the Auditor should have done was to require the plaintiff to prove what the defendant actually got for each shelf sold. The names of the purchasers were given and had the plaintiff taken the trouble to follow them up it could have been ascertained what each purchaser actually paid. The burden was upon the plaintiff.

The exception should have been allowed on the ground that the Auditor reached his conclusion about the average selling price by a series of guesses and assumptions not justified by the evidence.

SECOND EXCEPTION.

Second Exception.—For that the said Auditor in his said report found that the average cost to the defendant of the manufacture of shelves of the form and description illustrated in "Exhibit O. S. Mfg. Co.'s Catalogue. Fig. 17," and of the form and description illustrated in "Exhibit Hansmann Sketch" in combination with cases, was 99 cents per shelf, whereas he should have found that he was unable to find from the evidence what such cost of manufacture was.

There is no basis in the evidence for the Auditor's assumption that the average cost of shelves in cases was 99 cents per shelf with case. The Auditor made a palpable mistake. He assumed that the entire number of shelves purchased in cases was 46,623 and he found that the aggregate cost of the entire number of shelves was $46,138.88. This cost price he divided by the total number of shelves, with the result of showing an average cost price of 99 cents per shelf and case. The error in his finding consists in the assumption that there were 46,623 *combined shelves and cases* purchased, whereas the proofs show that this number 46,623 includes 2,206 shelves that were purchased without cases. (See Defendant's exhibit "Exhibit Shelves Without Cases" (p. 279) and defendant's statement of November 20, 1890, (p. 233) To find the average cost of shelves in cases, or, more properly, of the combined cases and shelves, it is manifestly necessary that the shelves that were purchased without cases should be left out of the computation. The Auditor's error is an error in favor of the defendant. but is nevertheless an error, shows imperfect calculation and the exception should have been allowed.

THIRD EXCEPTION.

Third Exception.—For that the said Auditor in his said report found that the estimated average cost price to defendant of the shelves alone was 49½ cents per shelf (the same being one-half of the estimated average

cost of shelf and case together); whereas in view of the certain and explicit evidence afforded by "Exhibit Shelves Without Cases" (p. 269) and defendant's statement of Nov. 20, 1896 (p. 233), showing that the lowest actual cost price to the defendant of any shelf without a case was 70 cents per shelf and the average cost price of 2,206 shelves without cases was a fraction over 87 cents per shelf, he should have found that the average cost price to defendant of a shelf alone was not less than 87 cents and a fraction.

The error pointed out by this exception is partly due to the adoption by the Auditor of the results of his false calculation noted in the second exception and partly due to other conditions. The Auditor assumed that the average cost price of the combined shelves and cases was 99 cents, and in order to arrive at the cost of the shelves alone, as separate articles, he divided the 99 cents by 2, intending thereby to apportion the cost of the combined shelf and case, one-half or 49½ cents to the shelf and the other half to the case. In discussing the second exception we have pointed out his mistake in assuming that 99 cents was the average cost of a combined shelf and case. His error in assuming the cost price of the shelf alone to have been one-half of 99 cents or 49½ cents is palpable. The allowance of one-half for the case was arrived at by pure speculation and guess work, and the attributing of one-half only of the cost of the combined shelf and case to the shelf is contrary to the most positive and convincing evidence afforded by the record. The cost of shelves alone, which was the ultimate item the Auditor had to deal with, is shown conclusively by the evidence concerning the cost of the 2,206 separate shelves purchased without cases, afforded by "Exhibit Shelves Without Cases," referred to in defendant's statement of November 20, 1896 (p. 233), and verified by the Yawman & Erbe bills, in evidence. A careful examination of "Exhibit Shelves Without Cases" (p. 279) will show that the lowest actual cost price of any shelf *without a case* was 70 cents, and that the average

cost price of the 2,206 separate shelves, without cases, was a fraction over 87 cents per shelf. The Auditor should, therefore, have found that the average cost price to defendant of a shelf alone was not less than 87 cents and a fraction, instead of finding that such average cost per shelf was 49½ cents.

The error pointed out by this exception shows how wise and salutary the rule is that requires a plaintiff to show the defendant's profits by positive and explicit direct evidence and excludes him from resorting to speculation, conjecture and guess work. For the reasons stated, this exception should have been allowed.

FOURTH EXCEPTION.

> *Fourth Exception.*—For that the said Auditor in his said report found that the New No. 4 Roller Shelf is substantially the same in form and description as the shelf illustrated in "Exhibit Office Specialty Mfg. Co.'s Catalogue, Fig. 17," and in "Exhibit Hansmann's Sketch," and an infringement of claims 1 and 2 of the Hoffman patent in suit; whereas he should have found that said New No. 4 Roller Shelf was substantially different from said above-mentioned exhibit shelves and not an infringement of said claims 1 and 2 of the Hoffman patent in suit.

This exception is directed to the Auditor's finding that the New No. 4 Shelf was an infringement of claims 1 and 2 of the patent in suit, and his error in this respect is pointed out in the preceding pages of this brief where the question of infringement is discussed. Judge Cox refused to consider the question of infringement of the New No. 4 Shelf (p. 299), and the Court of Appeals overruled him.

FIFTH EXCEPTION.

> *Fifth Exception.*—For that the said Auditor in his said report found that the average gross proceeds of the sales attributable to the shelves separately from cases is $1.135

per shelf; whereas he should have found that he was unable to ascertain from the evidence the average gross proceeds.

The error pointed out by this exception is explained in treating hereinabove the first exception.

SIXTH EXCEPTION.

Sixth Exception.—For that the said Auditor in his said report found that the average cost of manufacture of said shelves separate from cases is .495 per shelf; whereas he should have found from the evidence afforded by "Exhibit Shelves Without Cases" and defendant's statement of November 20, 1896 (p. 233), that the average cost of manufacture of said shelves, separate from cases, was not less than 87 cents and a fraction per shelf.

The error pointed out by this exception is discussed in our treatment of the third exception.

SEVENTH EXCEPTION.

Seventh Exception.—For that the said Auditor in his said report found the net profits realized by the defendant from the sale of the 25 shelves like "Exhibit Office Specialty Mfg. Co.'s Catalogue, Fig. 17," to September 1, 1896, to be $5.125 as shown in Schedule B; whereas he should have found that defendant had realized no profits from the sale of said shelves.

The erroneous calculation referred to in this exception is the result of the errors of computation pointed out in considering the first, second and third exceptions.

EIGHTH EXCEPTION.

Eighth Exception.—For that the said Auditor in his said report found the net profits realized by the defendant from the sale of the shelves described in "Exhibit

Hansmann's Sketch " to be $5,775.05 as shown in Schedule B. whereas he should have found that defendant had realized no profits from the sale of said shelves.

The erroneous calculation of the Auditor pointed out in this exception results from the errors considered in treating the first, second and third exceptions.

NINTH EXCEPTION.

Ninth Exception.—For that the said Auditor in his said report found the net profits realized by the defendant from the sale of the shelves designated as New No. 4 Roller Shelf to September 1, 1896, to be $4,777.53 as shown in Schedule D; whereas he should have found that defendant had realized no profits from the sale of said shelves.

The erroneous calculation of the Auditor pointed out by this exception results from the errors pointed out in treating the first, second and third exceptions.

TENTH EXCEPTION.

Tenth Exception.—For that the said Auditor in his said report refused to consider the testimony of Alexander S. Steuart, an expert witness, called by defendant on the question of the infringement of the New No. 4 Shelf; whereas he should have considered and given due weight to said testimony on said question.

There was manifest error on the part of the Auditor in excluding from consideration the testimony of Mr. Steuart, who was called to explain the plaintiff's patent and the New No. 4 Shelf on the issue of new infringement raised for the first time before the Auditor. Such testimony was as manifestly competent before the Auditor as it would have been before the court on such an issue.

ELEVENTH EXCEPTION.

Eleventh Exception.—For that the said Auditor in his said report refused to consider the testimony of the said Alexander S. Steuart respecting the prior state of the art in relation to claims 1 and 2 of the Hoffman patent in suit and the bearing of said claims on the alleged infringing New No. 4 Shelves; whereas said Auditor should have considered and duly weighed said testimony on said question.

Evidence as to the pior state of the art is always admissible as an aid in the proper construction of a patent whenever that question of construction arises.

Brown *vs.* Piper, 91 U. S. 37.
Grier *vs.* Wilt, 120 U. S. 412.
Robinson on Patents, Vol. 3, par. 1020.

The new issue of infringement raised by the presentation of the matter of the alleged infringement of the New No. 4 Shelf to the Auditor required the Auditor, in the absence of any opinion of the court construing the patent, to himself give a construction to the patent in order to decide the question of infringement. The evidence of Mr. Steuart was, therefore, relevant to such an issue and should have been given due consideration

TWELFTH EXCEPTION.

Twelfth Exception.—For that the said Auditor in his said report has awarded plaintiff profits alleged to have been realized by the defendant, notwithstanding it appears from the bill of complaint and evidence offered by the plaintiff that the plaintiff manufactures under the Hoffman patent in suit, and neither the bill nor the evidence discloses that the plaintiff has marked its articles made under said patent with the word "patented" together with the day and year the patent was granted, nor that the defendant was duly notified of its infringement and continued after such notice, to make, use or vend the article so patented; whereas he should have refused to award any profits or damages because of the inhibition of Sec. 4900 Revised Statutes.

Sec. 4900 R. S. U. S. reads as follows:

> SEC. 4900. It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented, either by fixing thereon the word "patented," together with the day and year the patent was granted, or when from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is inclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, *no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the articles so patented.*

This section of the statute makes it a *sine qua non* that the plaintiff suing for the infringement of a patent must, as a condition precedent to a recovery, show that he has either marked his goods in accordance with this statute or else must prove "that the defendant was duly notified of the infringement and continued after such notice to make, use, or vend the article so patented."

The bill in this case makes no allegation respecting either marking or notice, and the proofs fail to show either marking or notice. Under the authorities, there can be no recovery.

> Dunlop *vs.* Schofied, 152 U. S. 259.
> Traver *vs.* Brown, 69 O. G. 1071.
> Blount *vs.* Bardsley, 66 F. R. 761.
> Allen *vs.* Deacon, 21 F. R. 122.

In National Co. *vs.* Belcher, 68 F. R. 665, Judge Dallas, Circuit Judge, said:

> Upon the authority of Dunlop *vs.* Schofield, 152 U. S. 244, 14 Sup. Ct. 576, I sustain the point made for respondents that "there can be no recovery for damages and no accounting for profits because the plaintiff has failed to allege in the bill of complaint either that the patented devices were marked 'patented' or that actual

notice of that fact was given to the defendants, as required by Section 4900, Revised Statutes." In Allen *vs.* Deacon, 21 F. R. 122, it was held in a suit in equity that in the absence of marking or notice, neither damages or profits can be recovered.

In conclusion it is contended by defendant:—

First, that the plaintiff's patent is invalid and void for want of patentable invention in the subject-matter.

Secondly, that if said patent can be sustained at all, it must be held to be limited to the precise structure shown and described in it, and as defendant has not made, used or sold such a structure, it has not infringed.

Thirdly, that the defendant has not been shown by any evidence which the law regards as sufficient to have made any profit to which the plaintiff is entitled.

Fourthly, that as the plaintiff is shown to be a manufacturer under the patent in suit and has not shown either that it marked its patented article with the word "patented," or gave the defendant notice of infringement, there can be no recovery in view of Sec. 4900 Revised Statutes.

Fifthly, that the decree of the Court of Appeals of the District of Columbia should be reversed, with instructions to direct the Supreme Court of the District of Columbia to dismiss the plaintiff's bill, with costs.

MELVILLE CHURCH,
JOSEPH B. CHURCH,
Solicitors and of Counsel for Appellants.

March 21, 1899.